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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,650	10/22/2003	Haruo Akiba	244334US3	5962

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ALEXANDRIA, VA 22314

EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,650

Applicant(s)

AKIBA, HARUO

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on June 8, 2005, amended claims 1, 2, 6, 7 and 9 and new claims 10-11 are acknowledged. The rejection of claims 1-9 under 35 USC § 102 is *withdrawn*. The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,863,286 to Yabe et al.

In regards to claims 1 and 10-11, Yabe et al. disclose a valved plug 61 to be fitted on a mouth piece at an inlet opening of an instrument entrance passage leading to a biopsy channel of an endoscopic insertion tube, the plug being formed of a resilient material in its entirety and having, at opposite ends of a foldable connecting strip 65, a generally tubular main body portion internally formed with a constricted passage of a smaller diameter as compared with the inlet opening of the instrument entrance passage at an intermediate portion between outer and inner ends thereof, and a nesting piece adapted to be detachably and tightly coupled with the main body portion and having a normally closed slit valve in axial alignment with the constricted passage in

Art Unit: 3739

the main body portion to permit insertion of an instrument therethrough, wherein: the main body 63 portion is provided with an interlocking inward projection of a predetermined thickness at an outer end to be coupled with the nesting piece 64; the nesting piece is provided with an annular interlocking groove around an outer periphery thereof, the interlocking groove being narrower the predetermined thickness of the interlocking projection and adapted to engage with the interlocking projection tightly from upper lower and inner sides to hold the interlocking projection in a compressed state (see Figs. 5 and 11 and Col. 10, Lines 57-67).

In regards to claim 2, Yabe et al. disclose a valved plug wherein the interlocking projection is an annular ledge projecting radially inward from an outer end of the main body portion on the outer side of the constricted passage (see Fig. 11)

In regards to claim 3, Yabe et al. disclose a valved plug wherein the annular ledge is so dimensioned as to have an inside diameter smaller than diameter of the annular interlocking groove of the nesting piece (see Fig. 11).

In regards to claim 4, Yabe et al. disclose a valved plug wherein an annular recess is formed between the interlocking projection and the constricted passage of the main body portion, the annular recess being so dimensioned as to have an inside diameter smaller than outside diameter of the interlocking groove on the side of the nesting piece (see Fig. 11).

In regards to claim 5, Yabe et al. disclose a valved plug wherein the interlocking projection of the main body portion is tightly engaged with the interlocking groove on

Art Unit: 3739

the side of the nesting piece through tapered or inclined surfaces and retained in an interlocked state more tightly by wedge-like actions of the tapered surfaces when an axial force is exerted thereto from inside of the biopsy channel (see Fig. 11 and Col. 11, Lines 1-21).

In regards to claim 6, Yabe et al. disclose a valved plug wherein the circular body portion of the nesting piece is formed in a hemispherical cup-like shape, and the slit is formed across a bottom portion of the hemispherical body portion (see Fig. 11).

In regards to claim 7, Yabe et al. disclose a valved plug wherein the main body is internally provided with a hollow cavity 63a under the constricted passage, and the slit is formed radially within a range of the hollow cavity (see Fig. 11).

In regards to claim 8, Yabe et al. disclose a valved plug wherein the slit is formed in an area inward of the interlocking projection on the side of the main body portion of the plug (see Fig. 11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 5,863,286 to Yabe et al. in view of U.S. Patent No. 4,715,360 to Akui et al.

In regards to claim 9, Yabe et al. disclose a valved plug 61 to be fitted on a mouth piece at an inlet opening of an instrument entrance passage leading to a biopsy

Art Unit: 3739

channel of an endoscopic insertion tube but is silent with respect to wherein a ridge is formed on one of engaging surfaces of the main body portion and nesting piece, the ridge being adapted to be deformed into a flattened shape by compression as the nesting piece is coupled with the main body portion of the plug. Akui et al. teach of an analogous valved plug having a ridge being adapted to be deformed into a flattened shape by compression as the nesting piece is coupled with the main body portion (see Col. 5, Lines 37-54). It would have been obvious to one skilled in the art at the time the invention was made to include a deformable ridge in the apparatus of Yabe et al. to ensure a secure fit between the nesting portion on the main body of the valved plug, as taught by Akui et al.

Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 3739

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK



7/8/05



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